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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,725	02/18/2004	Jean-Louis Gueret	118556	1716

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EXAMINER

RUNNING, RACHEL A

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

JP

Office Action Summary	Application No.	Applicant(s)	
	10/779,725	GUERET, JEAN-LOUIS	
	Examiner	Art Unit	
	Rachel A. Running	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 29-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/18/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I, drawn to a brush endpiece.

Species II, drawn to a flexible endpiece.

Species III, drawn to a flocked endpiece.

Species IV, drawn to a foam endpiece.

Species V, drawn to a comb endpiece.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1-25 and 29-41 are generic.

2. Applicant's election with traverse of Species I claims 1-27 and 29-41 in the reply filed on January 5, 2006 is acknowledged. The traversal is on the ground(s) that the inventions are related and thus there is not serious burden shown. This is not found persuasive because this is an Election of Species. As set forth in MPEP 808.01(a), where there is no disclosure of relationship between species, they are independent inventions and election of one invention following a requirement for restriction is mandatory even though applicant disagrees with the examiner. There must be a patentable difference between the species as claimed. Since the claims are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121, and it is not necessary to show a separate status in the art or separate classification. Thus a proper

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traversal would include a statement by applicant that the species are not distinct, but rather are obvious variations of one another.

The requirement is still deemed proper and is therefore made FINAL.

3. Claim 28 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 5, 2006.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the applicator element being connected in a removable manner from the base portion must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. In claim 30 the applicant states that,

"...the applicator element has a free end situated on a same side as the handle portion when the angle between the axes of the base portion and handle portion is at a maximum."

It is unclear how the free end of the applicator is situated on the same side of the base portion as the handle portion.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5, 7-10, 12, 16, 17, 25, 26, 30-35, and 37-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Gueret (U.S. Patent No. 5,391,011). Gueret discloses a base portion (20) carrying an applicator element (21) configured for fixing onto a receptacle (10) see Figures 2 and 3 (column 2, lines 35-45). A handle portion (30) rotably mounted on the base portion to turn about a fixed axis of rotation, wherein the axis of rotation and the longitudinal axis of the handle portion are not mutually perpendicular see Figure 3. The axis of rotation and the longitudinal axis are not parallel, and the axis of rotation and an axis of the base are not mutually perpendicular, because the handle can rotate at different positions relative to the longitudinally axis and the axis of the base is not specified. The base portion and the handle portion cooperate to enable a user to secure the handle portion in at least two predefined position relative to the base (column 3, lines 10-15). The base portion is arranged to be fixed on the neck of the receptacle by screw-fastening, and the fixing means is leaktight (column 2, lines 60-65). The base portion and the handle portion are made of a material that provides a good grip (column 2, lines 60-65). At least one of the base portion and the handle portion includes a pin (133), which is engaged in a housing in the base portion see Figure 3. The applicator includes a stem having a first end which comprises a brush (21) and a second end see Figure 3 (column 2, lines 40-45). The applicator is configured for applying a product on at least one of the lips, eyelids, eyelashes, eyebrows, and hairs of the user (column 1, lines 38-40).

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7. Claims 1-6, 10-18, 20, 23, 25-27, 30, 33, 34, and 37-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Stange (DE 296 14 364). Stange discloses a base portion (2) carrying an applicator element (4) configured for fixing onto a receptacle see Figures 1 and 2. A handle portion (3) rotably mounted on the base portion to turn about a fixed axis of rotation, wherein the axis of rotation and the longitudinal axis of the handle portion are not mutually perpendicular see Figures 2 and 3. The axis of rotation and the longitudinal axis are not parallel, and the axis of rotation and an axis of the base are not mutually perpendicular. The base portion and the handle portion co-operate to enable a user to secure the handle portion in at least two predefined position relative to the base see Figures 2 and 3. The handle portion (12) and the base portion (11) co-operate to produce a click sound see Figure 2. At least one of the base portion and the handle portion has a relief (5), which allows the base portion, and the handle portion to provide a good grip see Figure 1. The base portion includes a surface that is inclined relative to the axis of the base portion, and the axis of rotation extending substantially orthogonally to the inclined surface see Figure 2. At least one of the base portion and the handle portion includes a pin (9), which is engaged in a housing in the base portion see Figure 2. The handle portion includes an insert (10) that enables the handle portion to be fixed onto the base portion by snap-fastening see Figure 2. The applicator includes a stem having a first end which comprises a brush (4) and a second end see Figure 2. The applicator is configured for applying a product on at least one of the lips, eyelids, eyelashes, eyebrows, and hairs of the user.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stange in view of Yamada (U.S. Patent No. 5,815,875). Stange discloses the claimed invention except for the pin being a split pin. Yamada teaches a split pin which secures a handle to base see Figure 4 and 5 (column 2, lines 40-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the pin of Stange be a split pin as taught by Yamada in order to allow the pin to fit into the hollow of the base and then lock into place by expanding.

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stange. Stange discloses the base portion including a pin arranged to be snap-fastened into the corresponding opening in the handle portion instead of the handle portion including a pin arranged to be snap-fastened into a corresponding opening in the base portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made have the handle portion include a pin arranged to be snap-fastened into a corresponding opening in the base portion, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

11. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stange in view of Riemann (U.S. Patent No. 4,922,575). Stange discloses the claimed invention except for the handle portion including fins and a body to which the fins are attached. Riemann teaches having fins (24b) on a handle portion see Figure 9 (column 1, lines 55-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the handle portion of Stange with fins as taught by Riemann to provide the mechanical advantage of torque and improved gripping.

12. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stange in view of Kingsford (U.S. Patent No. 5,137,038). Stange discloses the claimed invention except for the base portion and handle portion including at least one marker and the other base portion and handle portion including an index. Kingsford teaches having a base portion with an index (6) and a handle portion with a marker (5) see Figures 1 and 2 (column 3, lines 10-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the handle and base of Stange with an index and maker as taught by Kingsford in order to allow the user to move the handle and base to the next position by aligning the maker and index.

13. Claims 27 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret (U.S. Patent No. 5,894,847). Gueret '011 discloses the claimed invention except for the brush having a non-rectilinear core (claim 27), and the receptacle including a wiper member (claim 36). Gueret '847 teaches having a non-rectilinear core (522) and a wiper member (521) see Figure 5 (column 2, lines 20-25 and 40-45). Regarding claim 27, it would have been obvious to one of ordinary skill in the art at the

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time the invention was made to make the applicator brush of Gueret '011 non-rectilinear as taught by Gueret '847 in order to have the brush contour to the user's eyelashes.

Regarding claim 36, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the receptacle of Gueret '011 have a wiper member as taught by Gueret '847 in order to allow the wiper element wipe off excess mascara from the brush.

14. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stange in view of Samaras et al. (U.S. Patent No. 3,164,856). Stange discloses the claimed invention except for the applicator element being removable from the base portion.

Samaras et al. teaches an interchangeable applicator portion see Figure 1 (column 3, lines 1-10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the applicator portion of Stange be removable as taught by Samaras et al. in order to allow the user to interchange the brushes in order to allow a different user to use a different applicator.

Conclusion

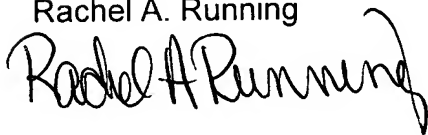
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel A. Running whose telephone number is (571) 272-1917. The examiner can normally be reached on Monday-Friday 8:00 am - 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rachel A. Running



Todd E. Manshan
Primary Examiner